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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,496	02/19/2004	Cherng-Chyi Han	HT03-020	5638

7590 09/06/2006
GEORGE O. SAILE
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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT PAPER NUMBER

2627

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/782,496	HAN ET AL.	
	Examiner	Art Unit	
	William J. Klimowicz	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicants' election with traverse of Group II (claims 1-17, drawn to a process) and the additional election of Specie I (corresponding to Figure 1, and the process of the invention associated therewith, i.e., Figures 3-6) in the reply filed on July 17, 2006 is acknowledged. The traversal as it pertains to the election of Group II (process claims) versus Group I (product claims) is on the ground(s) that:

upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to "a method to protect a magnetic write head during pole trimming", and that the product claims are directed to "a LDCR magnetic write head", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 29/603.15 and product class/subclass 360/126, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case the product could be made by a process not requiring the fabrication steps as articulated in the method claims, including the use of, inter alia, a chemical etch, laser ablation, etc. not specifically set forth in identifying Group I, etc." is speculative and has nothing to do with the Claims as presented in this patent application.

See page 2 of the Response filed on July 17, 2006. This is not found persuasive because the Examiner maintains that the product and process inventions are distinct for the reasons given in the previous restriction requirement, i.e., that the Group I claims 18-29, which are drawn to a magnetic write head, classified in class 360, subclass 126, and the Group II claims, 1-17, drawn to a method of fabricating a CPP spin valve structure, classified in class 29, subclass 603.15 are *a priori* distinct, each from the other since Inventions II and I are related as process of making and

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product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made by a process not requiring the fabrication steps as articulated in the method claims, including the use of, *inter alia*, a chemical etch, laser ablation, etc, not specifically set forth in the identified Group I, etc.

Moreover, because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

As it pertains to the Applicants' conjecture that the product can be made by another materially different process is mere speculation on the part of the Examiner, the Examiner maintains that all that is required to be shown is "a viable alternative process or product," and that "[a]llegations of different process or products need not be documented." See MPEP 806.05(f). the Examiner maintains that the materially different process to make the claimed product of the Applicant, is indeed a viable alternative.

As it pertains to the restriction between the product and process claims, the following should be noted. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

The traversal as it pertains to the election of Species I versus Species II is on the ground(s) that:

The Examiner is respectfully requested to reconsider the Requirement for Election of Species given in the Office Action, because of the increased costs applicant would be forced to bear if the two species are separately examined. Furthermore, the field of search must necessarily cover both species, in addition to other related Classes and subclasses, to provide a complete and adequate search.

Id. at p. 3. This is not found persuasive because the Examiner maintains that each identified Species and/or invention grouping, as articulated in the previous Requirement for

Restriction, would impose a grave and serious burden upon the Examiner. Moreover, in accordance with 37 CFR 1.104, to the nature of each distinctly grouped species and/or grouping, the Examiner must, make a thorough study thereof and a thorough investigation of the available prior art relating to the claimed subject matter of each distinctly identified species and/or grouping. The examination for each distinct specie/grouping must be complete with respect both to compliance of the application with the applicable statutes and rules and to the patentability of the invention as claimed, in addition to matters of form, including Title 35 to the United States Code, sections 101, 102, 103 and 112. to each distinctly grouped invention.

Moreover, each separately grouped specie/invention must be thoroughly searched, including, but not limited to, various searching fields, inclusive of differing text search strategies, determination of anticipation, if any, of uncovered prior art, application of the Graham factual inquiries to each distinct specie/invention..

Additionally, the Applicants' argument is not found to be persuasive because each of the various disclosed species details a mutually exclusive characteristic of a process of forming a distinct and exclusive magnetic head as evidenced by the representation of each various species with a different figure or set of figures. A search for one of these mutually exclusive characteristics is not coextensive with a search for the other mutually exclusive characteristics and therefore searching for all mutually exclusive characteristics could not be done without serious burden.

Moreover still, as has been held, if there is an express admission that the claimed inventions would have been obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

There is nothing on record to show that the distinctly grouped species/inventions are obvious variants.

The requirement is still deemed proper and is therefore made **FINAL**.

Claim Status

Claims 1-29 are currently pending.

Claims 1-11 have been considered on the merits, and have been indicated as containing allowable subject matter.

Claims 12-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention/specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 17, 2006.

Conclusion

This application is in condition for allowance except for the presence of claims 12-29 directed to an invention non-elected with traverse in the reply filed on July 17, 2006. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

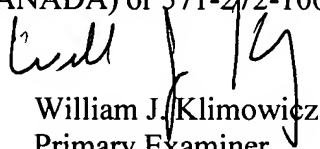
The prosecution of this case is closed except for consideration of the above matter.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


William J. Klimowicz
Primary Examiner
Art Unit 2627

WJK